SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 302

HARRIET J. FABER, Executrix of the Estate of Henry B. Faber, Deceased, and ETHEL L. DRIGGS, Executrix of the Estate of Louis L. Driggs, Jr., Deceased,

Petitioners,

vs.

TRIUMPH EXPLOSIVES, INC., and GLENN L. MARTIN COMPANY,

Respondents.

BRIEF IN SUPPORT OF WRIT OF CERTIORARI.

Statement.

The opinion below, jurisdiction, questions presented, statutes involved, and the specification of errors, are stated in the petition.

Summary of Argument.

1. The disclaimer filed as to Claim 1 of the first patent in suit did not add a new element and did not invalidate the claim.

2. The Vaxelaire and Rollet patents do not teach the invention covered by the first patent in suit.

3. The Vaxelaire, Rollet and Wilder patents do not teach the invention covered by the second patent in suit.

ARGUMENT.

(1) The disclaimer filed as to Claim 1 of the first patent in suit does not add a new element and did not invalidate the claim.

The Circuit Court of Appeals reversed the District Court and found that the disclaimer to Claim 1, filed on September 23, 1931, added a new element to the claim, and, therefore, the claim was invalid.

The disclaimer in question reads as follows:

> "By restricting the element 'cartridge casing' of said Claim 1 to 'closed at its rear end and capable of standing the strains of firing and ejecting completely a projectile therefrom without deformation of the cartridge casing'."

This is obviously a functional statement and it is the contention of your petitioners that this disclaimer merely modifies and restricts an element already in the claim, namely, the cartridge casing, and does not add any new element.

The validity of such a disclaimer has never been directly passed upon by this Court.

It is true that in the case of *Altoona Theatres* v. *Tri-Ergon Corp.*, 294 U. S. 477, 79 L. Ed. 1005, this Court held that the addition of an element (there a flywheel) invalidated the claim and was improper. It is further true that this Court, as recently as April 27, 1942, in the case of *Milcor Steel Co.* v. *George A. Fuller Co., et al.*, 86 L. Ed. 897, reiterated the doctrine of *Altoona Theatres* v. *Tri-*

Ergon Corp., supra, and held a similar disclaimer invalid. Additional structure was added by the disclaimer.

Here the disclaimer filed does not add any elements, but restricts the element "cartridge casing", already present in the claim, to being closed at its rear end and capable of standing the strains of firing and ejecting completely a projectile therefrom without deformation of the cartridge casing.

The language of the Court of Appeals is somewhat inconsistent (R. 200).

> "So also we find that the original claim speaks of a firearm 'adapted to be used with fixed ammunition provided with a *cartridge case'*. The claim describes the pistol, its firing mechanism and automatic means for holding the cartridge case in the barrel before and after firing, but does not describe the fixed ammunition itself. The disclaimer for the first time speaks of the cartridge case as an element of the claim and seeks to restrict this element to a cartridge case closed at the rear and strong enough to stand the explosion without deformation. The evidence does not show why the disclaimer was filed or what excess of invention, claimed through 'inadvertence, accident or mistake,' the patentee was attempting to correct under the permissive terms of R. S. Section 4917, 35 U. S. C. A. 65; but whatever the motive, the attempt to introduce this new element into a claim originally confined to the pistol cannot be sanctioned under the established rule. *See Altoona Theatres* v. *Tri-Ergon Corp., supra; Milcor Steel Co.* v. *George A. Fuller Co.,* 2 Cir. 122 F. (2d) 292."

The Court takes the position that the disclaimer, for the first time, speaks of the cartridge case as an element of the claim. If the cartridge case is not an element of the original claim, it is not an element of the claim after the filing of the disclaimer. In the original claim the cartridge case is

set up as defining the fixed ammunition, and the disclaimer does not change, in any way, the relationship of the cartridge case to the balance of the claim. If it was not an element of the claim, originally, nothing has been added. If it was an element of the claim, originally, then all the disclaimer did was to restrict the nature of the element already there, and not to add a new or different element. The language is purely functional in its nature.

While this Court has twice said that a new element cannot be added to a claim by a disclaimer, it has not ruled on the validity of this type of disclaimer, where no new element was added. The various Circuit Courts of Appeal are of different opinion on this point. The Second Circuit has said that this type of disclaimer is never valid. (*Milcor Steel Co.* v. *George A. Fuller Co.*, 122 F. (2d) 292.) The Circuit Court of Appeals for the Ninth Circuit, in *Payne Furnace & Supply Co.* v. *Williams-Wallace Co.*, 117 F. (2d) 823, 827, stated:

> "Counsel for appellant does not attack these cases as unsound or attempt to distinguish them. He simply ignores them. We do not understand that the Supreme Court in the Altoona Publix Theatres decision, supra, intended to overrule the many decisions upholding disclaimers of this character. We quote the footnote at page 490 of the opinion in 294 U. S. 55 S. Ct. at page 460, 79 L. Ed. 1005, omitting the citations there given: 'The use of the disclaimer has been upheld where the elimination from the patent of the matter not relied upon did not operate to enlarge the monopoly of the patent, but narrowed it, as by eliminating in their entirety some of the claims of the patent * * * or by striking out an alternative method or device * * * or by limitation of a claim or specification by deletion of unnecessary parts, * * * *or by limiting the claim to a specific type of the general class to which it was applied.*' (Emphasis supplied)."

The Circuit Court of Appeals for the Seventh Circuit has repeatedly held disclaimers of this type valid. *Johnson Laboratories, Inc.*, v. *Miessner Mfg. Co.*, 98 F. (2d) 937. The Court stated at pages 944 and 945:

> "A disclaimer is proper when the patentee has been wrong in asserting that the whole claim is new but right as to a part which constitutes invention and which does not depend upon what he disclaims."

The Sixth Circuit Court of Appeals has twice sustained this type of disclaimer. *Byrne Mfg. Co.* v. *American Flange & Mfg. Co.*, 87 F. (2d) 783; *Cincinnati Rubber Mfg. Co.* v. *Stowe-Woodward, Inc.*, 111 F. (2d) 239.

All of the cases cited are subsequent to the decision in *Altoona Theatres* v. *Tri-Ergon Corp., supra,* and show a clear conflict between the Second, Sixth, Seventh and Ninth Circuit Courts of Appeals. The Fourth Circuit, whose decision petitioners seek this Court to review in this case, follows none of the other Circuits, but quoted with approval the opinion of the Second Circuit in *Milcor Steel Co.* v. *George A. Fuller Co., supra.*

This Court recently handed down an opinion in *Milcor Steel Co.* v. *George A. Fuller Co.*, holding the disclaimer there invalid on the ground that a new element was added to the claims, and on the further ground that the revised claims changed the combination set out in the original claims.

The disclaimer here does not change the combination, add any additional element, nor change the character of the claimed invention in any way, and under the law laid down by the Sixth, Seventh and Ninth Circuit Courts of Appeals, is a valid and proper disclaimer.

It is submitted that there is an obvious conflict between the various Circuit Courts of Appeals not yet settled by this Court.

Since the disclaimer did not change the combination nor add any additional element, nor change the character of the claimed invention in any way, it is submitted that the Court of Appeals erred. It is further submitted that this Court should review this case to settle the conflict between the various Circuit Courts of Appeals.

(2) The Vaxelaire and Rollet Patents do not teach the invention covered by the first patent in suit.

The Court invalidated the first patent in suit, No. 1,712,382, (R. 130) in view of the three French patents, No. 594,962, issued to Vaxelaire on September 24, 1925, and Nos. 496,832 and 509,591, issued to Rollet on November 18, 1919 and November 13, 1919, respectively (R. 150-158). None of these patents have ever been used, with the exception of Rollet, No. 509,591 (R. 78, Finding 16, Dist. Ct.).

In its opinion the Court stated:

> "None of these French patents purports to show a complete structure consisting of a fire arm and fixed ammunition. They merely offer improvements to signalling pistols and signalling means that are *assumed* to be well known. But complete anticipation of the patent in suit is not essential to a determination of invalidity. It is very clear that the Vaxelaire patent showed an improvement to a signalling pistol, permitting it to be loaded, fired and unloaded by the use of one hand, and that taken together, the three French patents suggested a pistol adapted to be used with a cartridge casing closed at its base and having an annular groove near its base and strong enough to act as an auxiliary barrel to the pistol. It did not require invention in our opinion to introduce these improvements in the signalling pistols that were well known when the application for the first patent in suit was filed, or to devise the combination of that patent; and this plain absence of invention is not overcome by evidence of the commercial success of the Driggs and Faber pis-

tol even though it satisfied a long felt want. *Altoona Theatres* v. *Tri-Ergon Corp.*, 294 U. S. 477, 487. It may be added that the commercial success achieved was due to the practical advantage that flowed from the use of the fixed ammunition of the second patent in the pistol of the first patent and not from the pistol alone." (Emphasis supplied.)

The Vaxelaire patent does not show a complete apparatus and never went into production. The other patents all require two hands to operate. Both the District Court and the Circuit Court of Appeals recognized that the Vaxelaire patent did not show a complete operable device, and the record is replete with speculations as to how Vaxelaire intended his device to be used.

None of these foreign references show the combination set forth in Claim 1, regardless of whether or not the disclaimer to Claim 1 is considered, nor do they show the combination set forth in Claim 2.

The claims of this patent are as follows:

Claim 1. "A muzzle loading low pressure fire arm, adapted to be used with fixed ammunition provided with a cartridge case, comprising a pistol grip, a short smooth bore barrel, spring actuated firing mechanism with a trigger for releasing same, and automatic means for holding the cartridge case in said barrel before and after firing, with means for releasing same from said barrel when desired."

On September 23, 1931, a disclaimer was filed restricting Claim 1 as follows:

"By restricting the element 'cartridge casing' of said Claim 1 to 'closed at its rear end and capable of standing the strains of firing and ejecting completely a projectile therefrom without deformation of the cartridge casing'."

Claim 2. "A muzzle loading low pressure fire arm, adapted to be used with fixed ammunition provided

with a cartridge case, having an annular groove near its base comprising a hand grip, a short smooth bore barrel of large calibre, spring actuated firing mechanism with a trigger for releasing same, and means for retaining the cartridge case in said barrel before and after firing, or for releasing same from said barrel when desired, and means comprising a spring latch adapted to engage in said annular groove, and to be released by hand."

The rule governing the effect of prior foreign patents is well stated in *Harris Eames* v. *William S. Andrews et al.*, 122 U. S. 40, 30 L. Ed. 1073:

> "The rule governing defenses alleging the invalidity of the patent by reason of prior printed publications was stated by *Mr. Justice Clifford* in *Seymour* v. *Osborne*, (78 U. S.) 11 Wall. 516, 555 (20:33, 42) in this language: 'Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense, must be an account of a complete and operative invention, capable of being put into practical operation'."
>
> "The same rule was repeated by *Mr. Justice Strong* in the opinion of the Court in *Cohn* v. *U. S. Corset Co.*,

93 U. S. 366, 370 (23:907, 908), as follows: 'It must be admitted that, unless the earlier printed and published description does exhibit the later patented invention in such a full and intelligible manner as to enable persons skilled in the art to which the invention is related to comprehend it without assistance from the patent, or to make it, or repeat the process claimed, it is insufficient to invalidate the patent'. This rule was affirmed in *Downton* v. *Yeager Milling Co.*, 108 U. S. 466, 471 (27:789, 791)."

This case, and *Seymour* v. *Osborne*, cited therein, have often been quoted with approval by this Court and the lower courts. The Court's attention is invited to the decision of the Circuit Court of Appeals for the Ninth Circuit in *Carson* v. *American Smelting & Refining Co.*, 4 F. (2d) 463, 465:

"A foreign patent is to be measured as anticipatory, not by what might have been made out of it, but by what is clearly and definitely expressed in it. An American patent is not anticipated by a prior foreign patent, unless the latter exhibits the invention in such full, clear, and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments. Seymour v. Osborne, 11 Wall. 516, 555, 20 L. Ed. 33; Hanifen v. Armitage (C. C.) 117 F. 845; Permutit Co. v. Harvey Laundry Co. (C. C. A.) 279 F. 713; General Electric Co. v. Hoskins Mfg. Co. 224 F. 464, 140 C. C. A. 150. In Westinghouse Airbrake Co. v. Great Northern Ry. Co. 88 F. 258, 31 C. C. A. 525, the court said: 'The prophetical suggestions in English patents of what can be done, when no one has ever tested by actual and hard experience and under the stress of competition the truth of these suggestions, or the practical difficulties in the way of their accomplishment, or even whether the suggestions are feasible, do not carry conviction of the truth of these frequent and vague statements'."

It is apparent from the opinion of the Circuit Court, itself, that none of the references relied on taught the invention covered by the first patent in suit. It is likewise apparent that the Court adapted elements from the three incomplete French patents to negative the invention. In *Hamilton Bates, et al.* v. *Charles W. Coe,* 98 U. S. 31, 25 L. Ed. 68, 74, this Court stated:

> "Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in the third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement."

The commercial success of the patents in suit is not disputed, nor is the fact that they filled a serious need. As found by the District Court, Conclusions of Law, 10, 11 (R. 80):

> 10. "Where there is doubt as to the clearness and completeness of prior publications, the commercial success of a patent in suit, especially in a crowded field, may be taken as strong evidence that the matter disclosed was not obvious to the ordinary person skilled in the art, for otherwise, it would have been reduced to practice; and this rule is enforced with particular strictness when the prior disclosures are found in foreign patents."
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> 11. "Patents Nos. 1,712,382 and 1,712,383 are combination patents. While some of the individual elements may be found scattered in numerous prior patents, none of the patents shows the complete combination. The problem was never solved until the patented

combinations were put together. This is invention that is entitled to protection."

It is submitted that the subject matter covered by the first patent in suit constituted invention and is entitled to protection, and that the Circuit Court of Appeals erred in reversing the District Court.

(3) Hhe Vaxelaire, Rollet, and Wilder patents do not teach the invention covered by the second patent in suit.

The Court, in holding the second patent (R. 135) in suit invalid, went even further than with the first patent in that it attempted to combine the three French patents with the English patent to Wilder to anticipate the claims. The Court originally held the second patent in suit valid, but on re-argument, reversed itself.

Claim 2, which is characteristic of the second patent in suit, reads as follows:

> Claim 2. "Fixed ammunition, for use with low power smooth bore firearms, having a short barrel of large calibre, said ammunition comprising a cartridge case forming an auxiliary barrel for the small arm and provided with a rearwardly projecting portion adapted to slide freely in the gun barrel with a propelling charge in the rear end of said cartridge case, and having a chamber for the expansion of the gases from the propelling charge, and said cartridge case having a loading chamber in front of said expansion chamber with a projectile mounted in said loading chamber, and adapted to be ejected therefrom by the gases from the propelling charge, said projectile comprising a tube closed at its rear slidably mounted in said loading chamber, signalling devices mounted in said tube and an expelling charge mounted in the base of said tube with means controlled by the firing of the small arm for igniting said expelling charge."

In originally sustaining the second patent, the Court stated:

> "We think that this combination was not disclosed in the prior art or even suggested by the Rollet patents in such a way as to disprove invention in the second patent in suit. Rollet had suggested the lodging of the flare in a metal case of which a part containing a wick for conveying the ignition was introduced in the bore of the gun and a part of larger diameter containing the fire works remained outside. He had also suggested that the cartridge case be closed at the rear end and be given sufficient strength to resist the explosion. But the combination of the patent comprised far more than this. It comprised a projectile casing containing the signal mounted in a cartridge casing that formed an auxiliary barrel for the pistol, an expelling charge in the projectile casing, means to ignite this charge after the projectile had been expelled from the cartridge and means to ignite the flare material in the projectile from the firing means of the pistol after the projectile had left the cartridge casing. Thus it is seen that *the novelty did not consist merely in the contents of the projectile or in the combination of a cartridge case containing a propelling charge for the projectile,* but enough more to constitute a successful apparatus for which there was a military need and which led to imitation by the defendant. The validity of the second patent was properly sustained." (Italics ours.)

After re-argument, the Court reversed itself and stated in part:

> "When we first considered this patent, we reached the conclusion that it disclosed a combination of inventive quality not shown in the Rollet patents or other prior art. We pointed out in an opinion, for which the present opinion has been substituted, that the combination of the patent comprised a projectile casing containing the signal mounted in a cartridge

casing that formed an auxiliary barrel for the pistol, an expelling charge in the projectile casing, means to ignite this charge after the projectile had been expelled from the cartridge, and means to ignite the flare material in the projectile from the firing means of the pistol after the projectile had left the cartridge casing; and we concluded that the novelty of this arrangement did not consist merely in the contents of the projectile, or in the combination of the cartridge casing and the projectile."

"But, upon further examination of the prior art, assisted by briefs and arguments of counsel upon rehearing, we are convinced that this conclusion was erroneous in that it failed to give sufficient weight to the British patent to Wilder, No. 128,975 of July 10, 1919, which was referred to in somewhat general terms but not specifically described in the original briefs or arguments. This patent disclosed a projectile enclosing a pyrotechnic signalling device of the kind adapted to be discharged into the air from a gun and to be suspended by a parachute. A more particular description of this projectile is not needed at this point for it has already been set out in the description of the projectile contained in our summary of the specifications and in Claims 2 and 7 of the second patent above set out. In short, it now appears that what we formerly attributed to the patentee as a new and substantial contribution to the art was in fact to be found in the Wilder patent. The projectile element of the second patent in suit is in fact the projectile of Wilder."

The projectile element as set forth in Claim 2 is merely claimed as a projectile comprising a tube closed at its rear end, slidably mounted in said loading chamber, signalling devices mounted in said tube and an expelling charge mounted in the base of said tube. No claim was ever made to novelty in the projectile, and from an examination of the original language of the Court, it is quite

clear that the Court did not so consider it. Even a cursory examination of Wilder (R. 150) shows that it is a breach loading shell with a flared end adapted to be used in the old type gun or Very pistol, with all of the disadvantages which the Court of Appeals found the present invention overcame.

Here we find the Court reversing itself and combining elements which it alleges are found in four separate foreign patents, none of which are related.

The law previously quoted in connection with Point I is doubly applicable here. It is interesting to note that while all of the foreign patents relied upon were theoretically available in 1919, it was not until 1928, when the inventors, Driggs and Faber, submitted their system, that the United States Army was furnished with satisfactory equipment.

Conclusion.

WHEREFORE, it is respectfully submitted that this petition for writ of certiorari should be granted.

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